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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91189418
Party	Plaintiff Speed Channel, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial Nos.:	77476098 77497086 77476107 77478035
Filed:	May 15, 2008 June 12, 2008 May 15, 2008 May 19, 2008
Marks:	SPEEDVISION SPEEDVISION SPEEDVISION HD SPEEDVISION (and Design)
Publication Date:	November 25, 2008 (for all opposed applications)

	)	
SPEED CHANNEL, INC.	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91189418
	)	
PHOENIX 2008 LLC	)	
Applicant.	)	
	)	

**SPEED CHANNEL, INC.’S OPPOSITION  
TO PHOENIX 2008 LLC’S MOTION FOR LEAVE TO FILE (1) MOTION TO STRIKE,  
OR IN THE ALTERNATIVE, (2) RESPONSE TO A NEW ISSUE RAISED BY SPEED  
CHANNEL, INC.’S REPLY**

Opposer Speed Channel, Inc. (“Speed Channel”) hereby opposes Applicant Phoenix 2008 LLS (“Applicant”) Motion for Leave to File (1) Motion to Strike or in the Alternative, (2) Response To A New Issue Raised By Speed Channel’s Reply (“Applicant’s Motion”).

Applicant’s Motion comprises Applicant’s latest attempt to express its outrage at being asked to comply with its discovery obligations, and to avoid the consequences of its failure to do so. Regardless, the Board should deny Applicant’s Motion, for at least three reasons. First, in

filing Applicant's Motion, Applicant violated the plain language of the Board's September 29, 2009, Order suspending this proceeding pending disposition of Speed Channel's Motion to Compel and instructing the parties to refrain from filing "any paper which is not germane to..." Speed Channel's September 29, 2009, Motion To (1) Compel Applicant's Responses To Speed Channel's First Set of Requests For Production of Documents and Its First Set Of Interrogatories; (2) Test The Sufficiency of Applicant's Responses to Speed Channel's Requests For Admissions; and (3) Suspend (Speed Channel's Motion To Compel ("Speed Channel's Motion to Compel"). Applicant's Motion is not germane to any of the issues raised in Speed Channel's Motion to Compel, to Applicant's response, or to Speed Channel's Reply. Accordingly, the Board should either deny Applicant's Motion or refuse to consider it.

Second, Applicant ignores the plain language of the TBMP, which expressly permitted Speed Channel to reply in support of its Motion to Compel.

Third, the Board should recognize that Applicant seeks nothing more than an opportunity to file a Sur-Reply Brief, which are expressly prohibited under TBMP § 502.02(b). Accordingly, and once again, The Board should either deny Applicant's Motion, or refuse to consider it.

## **I. INTRODUCTION AND FACTUAL BACKGROUND**

This is an Opposition proceeding. Speed Channel owns several trademarks registered with the United States Patent and Trademark Office for a variety of goods and services that incorporate the word "SPEED" (collectively, the "SPEED Marks") and which are associated with Opposer's cable television network, including, but not limited to:

1. United States Trademark Registration No. 3128705 for SPEED, covering "production and distribution of television and radio programs featuring sports and entertainment" in International Class 41;

2. United States Trademark Registration Serial No. 3302139, for SPEED (Stylized) and Design, covering “[p]roduction and distribution of television and radio programs featuring motorsports and entertainment; entertainment services in the nature of television and radio programming featuring motorsports; providing on-line information in the field of motorsports and entertainment via the Internet and wireless devices” in International Class 41;
3. United States Trademark Registration Serial No. 3302139, for SPEED (Stylized) and Design, covering “[p]roduction and distribution of television and radio programs featuring motorsports and entertainment; entertainment services in the nature of television and radio programming featuring motorsports; providing on-line information in the field of motorsports and entertainment via the Internet and wireless devices” in International Class 41;
4. United States Trademark Registration No. 2780662 for SPEED CHANNEL (Stylized) covering “[s]treaming of audio materials on the Internet and streaming of video materials on the Internet” in International Class 38 and “[p]roduction and distribution of television and radio programs featuring sports and entertainment” in International Class 41;
5. United States Trademark Registration No. 2805030 for SPEED ON DEMAND (Stylized), covering “[e]ntertainment services in the nature of sports television programs available via a global communications network in International Class 41;
6. United States Trademark Registration No. 3318207 for SPEED REPORT, covering “[e]ntertainment services in the nature of an ongoing television program featuring sports” in International Class 41;

7. United States Trademark Registration No. 3463037 for SPEED ROAD TOUR CHALLENGE, covering “[e]ntertainment services in the nature of a television series in the reality genre” in International Class 41; and

Speed Channel also owns United States Trademark Application Serial No. 78969990 (the “SPEED Application”) for SPEED GARAGE, covering “[e]ntertainment services in the nature of providing television programs and downloadable television programs featuring automotive repairs via the Internet; entertainment services in the nature of video programs featuring motor vehicles transmitted via wireless communication devices, namely cell phones, personal digital assistants, computers, and wireless handhelds; production and distribution of audio visual entertainment namely, video programs featuring motor vehicles transmitted via mobile communication devices, namely cell phones, personal digital assistants, computers, and wireless handhelds in International Class 41.

Opposer, or its predecessors in interest, have adopted and used the SPEED Marks throughout the world, including the United States, on or in connection with numerous products and services.

In addition to its rights in the SPEED Marks and the SPEED Application, Speed Channel owns common law rights in and to the trademark SPEEDVISION (the “SPEEDVISION Mark”). Speed Channel’s predecessor-in-interest, Speedvision Network, LLC, adopted and used the SPEEDVISION MARK at least as early as 1996.

Applicant Phoenix 2008 seeks to register four marks that are based upon, and that incorporate, that SPEEDVISION Mark (collectively, the Opposed Applications”). For the Board’s convenience, Table 1, which is set forth below, depicts the Opposed Applications.

<b>APPLICATION SERIAL NO., MARK AND DESIGN</b>	<b>FILING DATE</b>	<b>DESCRIPTION OF GOODS AND SERVICES</b>
77476098 SPEEDVISION	May 15, 2008	<p>Cable television broadcasting; Audio and video broadcasting services over the Internet; Radio and television broadcasting services in International Class 38</p> <p>Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through television broadcasts, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and pre-recorded digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs in International Class 41</p>
77497086 SPEEDVISION	June 12, 2008	<p>Publications, namely, newsletters, magazines, and journals in the fields of automobiles, airplanes, motorcycles, boats, and other modes of transportation in International Class 16</p>
77476107 SPEEDVISION HD	May 15, 2008	<p>Cable television broadcasting; Radio and television broadcasting services; Audio and video broadcasting services over the Internet in International Class 38</p> <p>Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through television broadcasts, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and pre-</p>


APPLICATION SERIAL NO., MARK AND DESIGN	FILING DATE	DESCRIPTION OF GOODS AND SERVICES
		recorded digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs in International Class 41
77478035 SPEEDVISION (and Design)  	May 19, 2008	Shirts; Pants; Jackets; Footwear; Hats; Headwear; Sweat shirts; Coats; Gloves in International Class 25  Cable television broadcasting; Radio and television broadcasting services; Audio and video broadcasting services over the Internet in International Class 38  Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through television broadcasts, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and pre-recorded digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs in International Class 41

TABLE 1

On November 25, 2008, all of the Opposed Applications published in the Official Gazette. Thereafter, Speed Channel requested and obtained ninety (90) day extensions of time to oppose the Opposed Applications.

On March 25, 2009, Speed Channel commenced the instant proceeding by filing a Notice of Opposition with the Board. Speed Channel opposes each of the Opposed Applications in each class for which Applicant seeks registration.

Discovery opened June 3, 2009. On June 4, 2009, Speed Channel served its Initial Disclosures, together with its First Set of Interrogatories, First Set of Requests For Production of Documents and First Set of Requests for Admissions (collectively, “Speed Channel’s Discovery Requests”). Copies of Speed Channels Discovery Requests are annexed as Exhibits A, C and E to Speed Channel, Inc.’s Motion to (1) Compel Applicant’s Responses To Speed Channel’s First Set of Requests For Production of Documents And Its First Set of Interrogatories; (2) Test The Sufficiency Of Applicant’s Responses To Speed Channel’s Requests For Admissions; and (3) Suspend (“Speed Channel’s Motion to Compel”)

On July 123, 2009, Applicant responded to Speed Channel’s Discovery Requests.

Thereafter, Speed Channel notified Applicant that its responses to Speed Channel’s Discovery requests were deficient.

On September 10, 2009, Speed Channel sent Applicant a letter (the “September 10, 2009, Letter”) providing a detailed explanation of the deficiencies in Applicant’s responses to Speed Channel’s Discovery Requests. A true and accurate copy of the September 10, 2009, Letter is annexed to Speed Channel’s Motion to Compel as “Exhibit G”

Applicant refused to correct the deficiencies in its responses to Speed Channel’s Discovery Requests. Accordingly, on September 28, 2009, Speed Channel filed the Motion to Compel. Thereafter on September 29, 2009, the Board issued an Order (the “September 29, 2009, Order”) suspending the instant proceeding pending disposition of Speed Channel’s Motion to Compel.



On November 2, 2009, Applicant opposed Speed Channel's Motion to Compel. In particular, Applicant claimed that it had supplemented its responses to Speed Channel's Discovery Requests. *See* Phoenix 2008 LLC' Response to Speed Channel, Inc.'s Motion to Compel and To Test The Sufficiency of Responses To Requests For Admissions ("Applicant's Response").

In its Response, Applicant claims that it supplemented its responses to Speed Channels Discovery Requests. *See* Applicant's Response, pp. 9 – 10.

On November 23, 2009, Speed Channel filed Speed Channel, Inc.'s Confidential Reply Memorandum Of Law In Support Of Its Motion To Compel. ("Speed Channel's Reply"). Speed Channel also filed a Non-Confidential version of its Reply.

In its Reply, Speed Channel addressed the additional deficiencies in Applicant's Response, including without limitation its attempt to supplements its responses to Speed Channel's Discovery Requests. *See* Speed Channel's Reply, pp. 3, 5, 6. Speed Channel also addressed Applicant's suggestions regarding the length of Speed Channel's Motion to Compel by setting for the relevant provisions of the TBMP by articulating the relevant provisions of the TBMP. *Id.* at p. 4. Speed Channel did not raise any issue not already presented in its Motion to Compel and in Applicant's Response. *Id.*

Apparently, Applicant found Speed Channel's arguments problematic. Thus, even though it was not permitted to do so, on December 5, 2009, Applicant filed the instant Motion. Applicant seeks leave to move to strike Speed Channel's reply or, in the alternative, (2) to file what amounts to a Sur-Reply Brief.

## **II. ARGUMENT**

The Board should either refuse to consider Applicant's Motion, or deny it, for at least three reasons, First, Applicant ignores the plain language of the Board's September 29, 2009, Order suspending this proceeding pending disposition of Speed Channel's Motion to Compel and instructing he parties to refrain from filing "any paper which is not germane to..." Speed Channel's September 29, 2009, Motion To Compel. Applicant Motion is not germane to any of the issues presented in Speed Channel's Motion to Compel; accordingly, (1) Compel Applicant's Responses To Speed Channel's First Set of Requests For Production of Documents and Its First Set Of Interrogatories; (2) Test The Sufficiency of Applicant's Responses to Speed Channel's Requests For Admissions; and (3) Suspend (Speed Channel's Motion To Compel ("Speed Channel's Motion to Compel").

Second, Applicant ignores the plain language of the TBMP, which expressly permits Speed Channel to reply in support of its Motion to Compel, which the Board may consider in its discretion.

Finally, Applicant ignores the fact that it is, essentially, attempting to file a Sur-Reply Brief, which the Board' rules expressly prohibit.

Based on the foregoing, the Board should either refuse to consider Applicant's Motion. Alternatively, the Board should deny it.

### **A. APPLICANT'S MOTION IS NOT GERMANE TO THE ISSUES PRESENTED IN APPLICANT'S MOTION TO COMPEL.**

Applicant ignores the plain language of the Board's September 29, 2009, Order suspending this proceeding pending disposition of Speed Channel's Motion to Compel. This Order provides that "[t]he parties should not file any paper which is not germane to... [Speed Channel's Motion to Compel]." *See* September 29, 2009, Order, p. 1.

Speed Channel's Motion to Compel is directed towards the deficiencies in Applicant's Responses to Speed Channel's Discovery Requests. According, the Board should consider Applicant's failure to comply with its discovery obligation as the germane issues presented in Speed Channel's Motion to Compel. The Board should further recognize that Applicant's Motion is predicated upon matters that are not germane to the resolution of Speed Channel's Motion to Compel, and either deny Applicant's Motion or, in the alternative, refuse to consider it. *See* September 29, 2009 ,Order (parties are not to file any paper which is not germane to the aforementioned motions.

The TBMP expressly permits the Board to refuse to consider pleadings that are not germane to the disposition of a motion to compel. *See* 37 CFR § 2.120(e)(2) ("When a party files a motion for an order to compel discovery, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order."); *see also* TBMP § 523.01. TBMP § 5123.01 provides that "[i]n accordance with 37 CFR § 2.120(e)(2), when a party files a motion to compel discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order."

In its Motion, Applicant neither suggests nor establishes that its Motion is germane to the issues presented in Speed Channel's Motion to Compel. Instead, in its Motion, Applicant devotes substantially all of its attention to addressing its unilateral decision to redact portions of its supplemental responses to Speed Channel's Discovery Requests, together with the deficiencies in its supplemental discovery responses, all of which arose **after** Speed Channel

filed its Motion to Compel.

Applicant could have raised any or all of the foregoing issues when it responded to Speed Channel's Motion to Compel. Applicant failed to do so, preferring instead to disregard the plain language of the Board's September 29, 2009, Order. Applicant could have raised the sufficiency of its redacted documents when it responded to Speed Channel's Motion to Compel. Applicant chose not to do so, preferring instead to ignore the Board's September 29, 2009, Order.

Regardless, the fact remains that Applicant violated the Board's September 29, 2009 Order by filing a paper that it not germane to Speed Channel's Motion to Compel when it filed its Motion. Accordingly, the Board should refuse to consider Applicant's Motion, or deny it.

**B. SPEED CHANNEL'S REPLY COMPLIES WITH, AND IS PERMITTED, UNDER THE TBMP.**

Applicant suggests that Speed Channel's decision to file a Reply in support of its Motion to Compel somehow violates the Board's rules. *See* Applicant's Motion, pp. 3 – 4. Applicant is wrong.

TBMP §502.02(b) permits a moving party to file a reply brief, which the Board may consider in its discretion. *See* TBMP § 502.02(b). The Board recognizes that a reply brief may be helpful when the reply brief clarifies issues presented in the pending motion. *See Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, n.4 (TTAB 2003) (reply brief considered because it clarified the issues under consideration); *see also Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998). In *Harjo*, the Board refused to strike a reply brief because the Board had elected to consider all of the parties' briefs, including the reply brief in question. *Id.* at 1791.

Applicant presents no reason why the Board should not consider Speed Channel's reply. Accordingly, the Board should follow *Harjo* by exercising its discretion and considering Speed

Channel's reply brief in support of its Motion to Compel.

Speed Channel's reply is also on all fours with the Board's decision in *Seculus a Amazonia*. In that case, the Board considered a reply brief because the brief "clarifies the issues under consideration herein." *Id.* at 1157 n. 4. In the instant matter, Speed Channel used its reply brief to identify additional deficiencies in Applicant's responses to Speed Channel's Discovery Requests. In doing so, Speed Channel presented the Board with an opportunity to address issues that are germane to its Motion to Compel, to address the additional deficiencies in Applicant's Response and to clarify the relevant issues pending before the Board. Accordingly, the Board should follow *Seculus a Amazonia* by denying Applicant's Motion.

**C. APPLICANT IS ATTEMPTING TO FILE A SUR-REPLY BRIEF, WHICH THE TBMP EXPRESSLY PROHIBITS.**

Applicant's suggestion that the Board permit it to move to strike Speed Channel's reply ignores the fact that Applicant's Motion constitutes an impermissible attempt to file a Sur-Reply Brief, which is expressly prohibited under the Board's rules. Accordingly, the Board should deny Applicant's Motion.

TBMP § 502.02(b) sets forth the types of briefs that parties may file. More particularly, Section 502.02(b) permits the parties to file a brief in support of a motion, a response to the motion and a reply, which the Board may, in its discretion, consider. *Id.* However, the Board will not consider further papers, including a sur-reply brief. *Id.* ("[n]o further papers (including surreply briefs) will be considered by the Board, and any such papers filed in violation of this rule may be returned to the filing party").

Applicant's Motion comprises precisely the type of sur-reply brief that the Board prohibits under TBMP § 502.02(b). In particular, Applicant seeks to address issues that it could have raised when it responded to Speed Channel's Motion to Compel, but did not. Accordingly,

the Board should find that Applicant's Motion is nothing more than a sur-reply brief, that it is not permitted under TBMP § 502.02(b) and that it should be denied and given no consideration.

### **III. CONCLUSION**

Applicant's Motion violates the plain language of the Board's September 29, 2009, Order. It disregards the fact that the Board's own rules, which expressly permit Speed Channel to file a reply in order to clarify issues that are germane to Speed Channel's Motion to Compel. Finally, it comprises an impermissible attempt to file a sur-reply brief that the Board's rules expressly prohibit. Accordingly, and for the foregoing reasons, the Board should deny Applicant's Motion or, in the alternative, refuse to consider it.

RESPECTFULLY SUBMITTED,  
Speed Channel, Inc.

Dated: December 28, 2009

BY:           /Daniel E. Bruso/            
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**CERTIFICATE OF SERVICE**

I, Daniel E. Bruso, Esq., counsel to Opposer Speed Channel, Inc. in Opposition Proceeding No. 91189418, certify that, on the 28th day of September 2009, I served a copy of SPEED CHANNEL, INC.'S OPPOSITION TO PHOENIX 2008 LLC'S MOTION FOR LEAVE TO FILE (1) MOTION TO STRIKE, OR IN THE ALTERNATIVE, (2) RESPONSE TO A NEW ISSUE RAISED BY SPEED CHANNEL, INC.'S REPLY, via first class mail, postage prepaid, upon:

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